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09/329,668	06/10/1999	PETER J. WILK	W07-424	8390

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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 06/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/329,668

Applicant(s)

WILK, PETER J.

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: p. 12 of the disclosure refers to Fig. 3 for description of Fig. 4.

Appropriate correction is required.

Drawings

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over RCT's Tips for Investors (RCT) and further in view of Venture-management firm launches on-line Forum, (Venture).

Claim 1. RCT discloses a method for facilitating financing of new technology, comprising:

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maintaining a host computer connected to a global computer network for receiving, over said network from remote computers, information describing purported advances in technology;

accessing said host computer to obtain said information;

(RCT p. 1 para 4 "appraise technologies sent to RCT for commercial potential...., note that RCT is internet based i.e. inherently includes a host computer and receives information over a network as recited);

performing an evaluation of said advances in technology to determine, for each of said advances, a fixed monetary amount to be contributed in exchange for a unit of equity in a prospective technology development venture to develop the respective one of said advances **(p. 1 para 5 Venture Development and financing plans...financing plans for adding value to early stage development which also include offering equity share in the technology venture);**

RCT fails to explicitly teach transmitting identifications of said advances together with respective values of the determined fixed monetary amounts as per claim 1.

Venture, in the same field of endeavor, however, teaches a method for facilitating financing of new technology **(financing....new venture para 1)**, to preselected computers **(investors who communicate on-line, p. 1)**, identifications of said advances together with respective values of the determined fixed monetary amounts **(refer to Venture p.1 and 2 venture capital on-line includes market place where investors are seeking entrepreneurial high growth companies which translates into the identification step as recited since investors needs both knowledge of identifications of the advances (detailed description of companies seeking venture capital as well as their respective values of determined fixed monetary amounts))**.

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It would have been obvious to one of ordinary skill in the art at time of the invention to implement the transmitting of identification of the advances together with respective values of the determined fixed monetary amounts as disclosed by the Venture article into the RCT reference so as to develop a method for facilitating financing of new technology as per claim 1 because the resulting method would facilitate communication of the technology advances together with their respective values of fixed monetary amounts to a large potential and interested investors without regards to any geographic or time limitations and would contribute to a more open, efficient and democratic financing of the new technology for which the financing is sought.

Claim 7. The method defined in claim 1 wherein the transmitting of said identifications and the respective values of the determined fixed monetary amounts is undertaken via said host computer **(the RCT is implemented on a web host and determination of fixed monetary amounts is by RCT, para 5 p.1)**

5. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over RCT and Venture references as applied to claim 1 above, and further in view of article "Revolution or Evolution? W.R. Hambrecht & Co. Brings underwriting to the Internet", The IPO Reporter, v 23, n 7, p4, Feb 1999 (hereafter the IPO Reporter)

Claim 2. the RCT and Venture articles as discussed above fail to teach the step of limitation of operating said host computer as recited in claim 2. In the same field of endeavor, however, the IPO Reporter teaches a method for facilitating financing of new

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technology wherein bids for desired numbers of units of equity in the technology development ventures are received over a network from a preselected computers for desired numbers of units of equity in the technology development ventures (referring to para 1 and 2 on p. 1, “marriage of the Internet and the IPOs”, “allocate shares to highest bidders”).

It would have been obvious to one of ordinary skill in the art at the time of invention to further implement the step in the RCT and ON-line combined method per claim 1 as discussed above to receive, over the network from at least some of the preselected computers respective bids for desired number of units of equity in the technology development ventures as per teaching of the IPO Reporter, because this step would facilitate participation by selected investors to bid for desired amount of shares or amount of investment in the advances in technologies in a similar fashion as financing of IPOs.

6. Claims 3-5: the cited and applied references fail to explicitly recite “setting a maximum number of units of equity”, “automatically tally totals of units” and “transmit a bidding termination signal” are routine and customary steps in IPO process.

The limitations recited in the subject claims refer to customary steps performed in trading and/or IPO offering by an entity such as a market maker or a managing firm of an IPO. Thus, the recited claim limitations are within the scope of references cited above because these procedural steps are required and anticipated in conducting of an on-line financing of new ventures or IPOs as discussed in the IPO reporter reference as an example. In this regard official notice is taken that setting a maximum number of units of equity, automatically tally total of units, transmitting bidding termination signals

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(as per recitation in claim 3), automatically advise the preselected computers (i.e. bidders) (claim 4), automatically record identities of preselected each computers (claim 5) are old and well known and anticipated in the art of trading of financing instruments including IPOs and therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these steps in the method for facilitating financing of new technologies as discussed in claim 2 analysis because this implementations would lead to a financing of new technologies (ventures) which would conform to the existing market and regulatory requirements, which would facilitate required communication of bidding status to the bidder and ultimately lead to more open, efficient and democratic financing of the new technologies.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over RCT and further in view of Venture-management firm launches on-line Forum, (Venture) as applied to claim 1 and further in view of McNabb (US Pat. 6,289,462).

As per analysis of claim 1, RCT and the Venture-management references while teach all limitations of claim 1, do not teach that identifications and respective values are transmitted in encrypted form. McNabb, in the same field of endeavor, however, teaches a method of providing security as applied to communication of data pertaining to financial transactions (McNabb col. 2 L 36-47) .

It would have been obvious to one of ordinary skill in the art at the time of invention to have the identification and the respective values transmitted in encrypted form because encryption of identification and the respective values would provide a

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measure of security from unauthorized access and thus would help maintain confidentiality of the transmitted data.

8. Claims 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over RCT above, and further in view of Leibovich, Mark; Journey Into the Secret Heart of Capitalism; The Washington Post, Aug 9, 1998 (Leibovich).

Per claim 8, RCT teaches a business method for enhancing investment in new technologies, comprising:

transmitting, to potential investors, investment opportunities each comprising an identification of purportedly new technology and a fixed monetary amount to be exchanged in return for a predetermined unit of equity in a prospective technology development venture to develop the respective technology (investment opportunities are technologies sent to RCT for commercial potential... para 4, p.1, financing plans for adding value... para 5, p.1 inherently teach the transmitting step since this financing requires seeking out potential investors as alluded to by "commercialization vehicles");

RCT fails to teach selecting a predetermined number of potential investors;

Leibovich, in the same field of endeavor, however, teaches a method for facilitating new technology wherein a predetermined number of potential investor are selected (para 8, few individual investors ...ipo price).

It would have been obvious to one of ordinary skill in the art at the time of invention to select a predetermined number of potential investors for transmitting the investment opportunities as disclosed by RCT because investors may be selected in a

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manner that such investors are highly motivated and likely to participate in the financing process thereby increasing it's likelihood of success.

RCT and Leibovich fail to teach steps of "receiving identities of the bidding investors", "recording identities of the bidding investors" and automatically tallying total units bid as recited in the subject claim. However, it is noted that these are customary steps performed in trading and/or IPO offering by an entity such as a market maker or a managing firm of an IPO. Thus, the claim limitations are within the scope of references cited above because these procedural steps are required and anticipated in conducting of an on-line financing of new ventures or IPOs.

Official notice is taken that receiving bids for units of equity from investors, recording identities of the bidding investors and the number of units of equity bid; automatically tally units of bid, and terminating bidding upon attainment of a preselected number of units sold are old and well known and anticipated in the art of trading of financing instruments including IPOs and therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these steps in the method for facilitating financing of new technologies as discussed in claim 2 analysis because this implementations would lead to a financing of new technologies (ventures) which would conform to the existing market and regulatory requirements, which would facilitate required communication of bidding status to the bidder and ultimately lead to more open, efficient and democratic financing of the new technologies.

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9. Claims 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over RCT and further in view of Leibovich, Mark; Journey Into the Secret Heart of Capitalism; The Washington Post, Aug 9, 1998 (Leibovich) as applied to claim 8 and further in view of Revolution or Evolution; The IPO Reporter, v23 n 7 p 4 , February 1999 (IPO Reporter).

Claim 9. The RCT and Venture references as discussed above in claim 8 analyses, fail to teach the step of limitation of operating said host computer as recited in claim 9. In the same field of endeavor, however, the IPO Reporter teaches a method for facilitating financing of new technology wherein respective identification and the respective fixed monetary amount over a global computer network (the Internet) are transmitted to potential investors using a host computer (referring to para 1 and 2 on p. 1, "marriage of the Internet and the IPOs", "allocate shares to highest bidders").

It would have been obvious to one of ordinary skill in the art at the time of invention to further implement the step in the RCT and the Washington Post combined method per claim 8 as discussed above to transmit, over the network from at least some of the preselected computers respective identification and the respective fixed monetary amount as per teaching of the IPO Reporter, because this step would facilitate participation by selected investors to bid for desired amount of shares or amount of investment in the advances in technologies in a similar fashion as financing of IPOs.

Claim 10. The method defined in claim 9 wherein the receiving of said bids for units of equity includes operating said host computer to monitor messages arriving over

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a global computer network (**RCT p.1, para 4, technologies sent to RCT for commercial potential**).

Claim 11. The method defined in claim 10, further comprising operating said host computer to monitor information arriving over said global computer network, said information describing purported advances in technology, further comprising selecting said prospective technology development venture from among the purported advances in technology described in the information arriving over said global computer network (**RCT p.1, para 4, technologies sent to RCT for commercial potential, p.1, para 5, ..when new technologies appear suitable for venture development, this recitation requires selection of the prospective technology received at the host computer of the RCT**).

Claims 12. The method defined in claim 11 wherein the automatic tallying of the total units bid includes operating said host computer to add units bid by respective ones of said bidding investors (**refer to analysis of claim 8**).

Claim 13. The references as applied to claim 12 analyses fail to explicitly teach transmitting of termination signal to the preselected computers.

However, official notice is taken that transmitting of termination signal to the prospective and actual bidders is old and well known and anticipated in the art of trading of financing instruments including IPOs and therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the step of transmitting of termination signal as recited in claim 13 because this would inform the bidders of the status of the bidding of the financial instrument.

Claim 14. analyzed as in claim 10

Claim 15. analyzed as in claim 12.

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Claim 16. analyzed as in claim 11.

Claim 17. analyzed as in claim 13.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ausubel (US Pat. 6,026,383) teaches a method for dynamic auction for multiple objects.

Donner (US Pat. 5,999,907) teaches an intellectual property audit system for valuing an intellectual property portfolio.

Risen Jr. et al. (US Pat. 6,018,714) teaches a method of protecting against a change in value of intellectual property.

Lovenheim, David A.; Before you knock on their door, know the venture game, Business Journal Serving Southern Tier, CNY, 4/13/98, Vol. 12 Issue 8, p.12 2p

Rice, Denis; The Internet and the Cybersecurities Marketplace, July 1998

Reed, Breet "Valuation of Intellectual Property for Licensing or sale: What's It Worth?" Oral Presentation at the American Conference Institute, pp. 1-42 (May 1995)

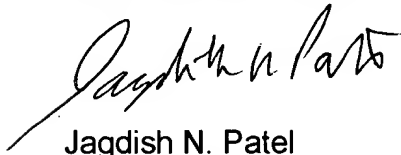
Rajkowski, E. Mark; Financing alternatives: What flavor is right for you?, Business Journal Serving Southern Tier, CNY, Mohawk Valley, Finger Lakes, North, 05/11/98, Vol. 12 Issue 10, p1T, 2p

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.

A handwritten signature in black ink, appearing to read 'Jagdish N. Patel', is written over the printed name.

Jagdish N. Patel

(Examiner, AU 2164)

June 11, 2002